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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,426	08/29/2001	Peter R. Horsfall	P/692-152	7416

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EXAMINER

AKINTOLA, OLABODE

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/942,426	Applicant(s) HORSFALL, PETER R.	
	Examiner Olabode Akintola	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/14/04; 6/25/02; 8/29/02; 10/10/03; 4/25/03</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>1/25/04</u> | |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 8-9, 12-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 22, 30, 37, 48, 59, 62-64 of U.S. Patent No. 7024386. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-2, 12-13 of the instant application corresponds to claims 1 and 8 of the USPN 7024386; claims 8-9 of the instant application corresponds to claim 1 of the USPN 7024386; and claims 14 of the instant application corresponds to claim 62 of the USPN 7024386.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-14 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Claims 1-14 are disclosed in Mills et al. (U.S. Patent No. 7024386).

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills et al (U.S. Patent No. 7024386) (Mills)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Re Claims 1, 8 and 13: Mills teaches computerized trading system for trading instruments between trading parties, comprising: a communications network for transmitting electronic messages; a plurality of trader order input devices connected to the communications network, each for generating electronic orders including bid and/or offer orders and for communication to traders of order information received from other input devices over the network; at least one broker order input device connected to the communications networks for generating electronic orders including bid and/or offer orders on behalf of a selected one of a plurality of client traders and for communication to a broker of order information received from other input devices over the network; at least one matching engine connected to the network for matching bid and offer orders input into the system from the order input devices and for executing deals where prices are matched; and a market distributor connected to the network for distributing order price messages to the order input devices,

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the market distributor being responsible to the order messages and the matching engine (col. 15, lines 61-col. 16, line 59 {claims 1 & 8}).

Re Claim 2: Mills teaches a credit store for storing an indication of credit available for trades between each trading party trading via one of the plurality of trader order input devices, whereby deals are executed automatically by the matching engine if sufficient credit for the deal exists between the counterparties, the credit limit further including an indication of whether credit is available for trades between a trading party trading via the broker order input device and a counterparty, the system further comprising a message generator for sending a message to the broker order input device and the order input device of a counterparty to a proposed deal, the deal confirmation message identifying the counterparty to the proposed deal and requesting confirmation from each counterparty that they wish to proceed with the deal (col. 16, lines 12-14; col. 8, lines 52-56; Figs 2-5).

Re Claim 3: Mills teaches a credit filter arranged to filter the order information to each order input device to distinguish information relating to orders with which the party represented by the order input device has sufficient credit to trade at least a portion of the order amount, and wherein the at least one broker order input device can select a given one of the plurality of the client traders whereby the order information displayed at the broker orders input device is filtered to distinguish dealable order information for the party of the selected client trader (col. 2, lines 1-5; col. 4, line 65-col. 5, line 1).

Re Claim 4: Mills teaches broker order input device is configurable to display order information

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relating to all orders submitted to the system (col. 4, line 34-45).

Re Claims 5 and 14: Mills teaches broker order input device is connected to a network node, the network node being arranged to submit order information from the broker order input device to the matching engine and to receive order information from other order input devices for communication to the broker order input device (col. 20, line 66-col. 21, line 15).

Re Claim 6: Mills teaches broker order input device includes means for inputting into the system, details of trades conducted outside the system with other brokers (col. 5, lines 19-31).

Re Claims 7 and 12: Mills teaches trader order input devices include means for disclosing the identity of a party to a trade to the broker order input device before a trade is agreed upon (col. 8, lines 62-64).

Re Claim 9: Mills teaches instruments traded are financial instruments (col. 4, lines 5-14).

Re Claim 10: Mills teaches the financial instruments are Forward Rate Agreements (FRAs) (col. 4, lines 5-14).

Re Claim 11: Mills teaches the order information conveyed to traders includes an indication of the amount of the market that has been entered by the broker order input device (col. 4, lines 33-46).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



OA

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